

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

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- I. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = S and forms a porphyrin and simple compositions thereof.
- II. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = S and forms a chlorin and simple compositions thereof.
- III. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = S and forms a bacteriochlorin and simple compositions thereof.
- IV. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = S and forms an isobacteriochlorin and simple compositions thereof.

- V. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = O and forms a porphyrin and simple compositions thereof.
- VI. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = O and forms a chlorin and simple compositions thereof.
- VII. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = O and forms a bacteriochlorin and simple compositions thereof.
- VIII. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = O and forms an isobacteriochlorin and simple compositions thereof.
- IX. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = Se and forms a porphyrin and simple compositions thereof.
- X. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = Se and forms a chlorin and simple compositions thereof.
- XI. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = Se and forms a bacteriochlorin and simple compositions thereof.

- XII. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = Se and forms an isobacteriochlorin and simple compositions thereof.
- XIII. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = Te and forms a porphyrin and simple compositions thereof.
- XIV. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = Te and forms a chlorin and simple compositions thereof.
- XV. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = Te and forms a bacteriochlorin and simple compositions thereof.
- XVI. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, wherein one of A, B, C, D, = Te and forms an isobacteriochlorin and simple compositions thereof.
- XVII. Claims 1-31 drawn to compounds of the general formula (I) stated in claim 1, that are not embraced by groups I-XVI and simple compositions thereof.
- XVIII. Claims 32-33 drawn to complex compositions using compounds in groups I-XVII.
- XIX. Claim 39 drawn to a method of treating a proliferative disease using compounds in groups I-XVII.
- XX. Claims 40-42 drawn to a process of making compounds in groups I-XVII.

Note: Election of a single disclosed chemical specie is required for any group elected.

The inventions listed as Groups I-XX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The prior art by Cho *et al.* (J.Org.Chem, see page 7896, equation 6), which is provided in the ISR, teaches species that read on the genus formula of claim 1. Therefore, the compounds and method are not novel and the invention lacks a special technical feature.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the

requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN MCDOWELL whose telephone number is (571)270-5755. The examiner can normally be reached on Monday-Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BEM

/Patrick J. Nolan/
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